

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	: Nitsche, et al.	Customer No.	: 21003
Serial No.	: 10/538,312	Confirmation No.	: 4052
Filed	: June 13, 2005	Group Art Unit	: 4183
Examiner	: Faragalla, Michael A.		
For	: METHOD FOR ESTABLISHING A CONNECTION BETWEEN A MOBILE STATION AND A COMMUNICATION NETWORK		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Electronically filed on March 9, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request review of the final rejections of claims 14, 16-20, 22-26, and 28 under 35 U.S.C. § 103 over *Lescuyer et al.*, European Patent No. EP1257141 (“*Lescuyer*”), further in view of *Gao et al.*, U.S. Patent No. 7,096,022 (“*Gao*”) and rejections under 35 U.S.C. § 103 in view of *Lescuyer* and *Gao*, further in view of the official notice alleged. At the outset, Applicants note that the Final Office Action states that claims 14-28 have been rejected but does not contain a reason for the rejection to claim 21. It is assumed that this was an oversight. Applicants nevertheless present the following remarks.

A Notice of Appeal is being filed with this request. A response is due by March 12, 2009. Thus, this response is timely filed. If any additional fee is due or over payment made

other than the fee accompanying this submission, Applicant authorizes the Director to charge any such fee, and credit any overpayment, to Deposit Account No. 02-4377.

Applicants present arguments concerning the patentability of claims 14-28 to address the Examiner's rejections. Applicants' silence with regard to any aspect of the Examiner's rejections of the dependent claims constitutes recognition by the Applicants that the rejections are moot based on Applicants' remarks relative to the independent claim from which the dependent claims depend.

Applicants submit that the Final Office Action does not establish a prima facie case of obviousness because the rejections merely argue that each of the claimed elements was known in the cited art and does not show a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

According to *KSR Int'l Co. v. Teleflex Inc.*, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." 550 U.S. 398, 418 (2007). "Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.* (emphasis added).

Claim 14 recites:

A method for production of a connection between a mobile station and a communication network, the mobile station performing the steps comprising:

automatically performing identification processes which identify usable connection options to different networks having different standards and frequency bands, wherein a first standard is selected and a check is carried out of the usable connection options within this first standard, then a next standard is selected and a check is carried out of the usable connection options within this next standard, and wherein connection parameters which identify

the standard with which a usable connection option is found are stored;
selecting a usable connection option; and
setting up a connection from the mobile station to the network via an access point after selection of connection parameters, wherein the connection is set up by the mobile station to the access point which is being communicated to via the standard for which the usable connection option has been selected.

It is alleged in the Final Office Action that *Lescuyer* teaches or suggests the “automatically performing”, “selecting”, and “setting up” features of claim 14 but does not show the feature of “the mobile station performing the steps” of claim 14. The Final Office Action states that *Gao* shows a user actively choosing an access network based on the user’s needs and that this disclosure, when combined with *Lescuyer*, renders claim 14 obvious.

Applicants submit that the rejections fall short of establishing a prima facie case of obviousness, especially in light of *KSR*.

Applicants submit that the rejections merely combine claimed elements that are independently and allegedly found in the cited references and does not establish that the claimed elements are combined in the way as recited in claim 14. Even assuming that *Gao* demonstrates a mobile station performing one or more tasks, the tasks performed by the mobile station are largely general tasks that are irrelevant to the thrust of the claimed subject matter. Applicants do not disagree that generalized mobile stations are found in the prior art, but mere recitation of a generalized mobile station cannot, when combined with *Lescuyer*, be said to perform the features in the way as recited in claim 14.

In addition, the Final Office Action alleges that *Gao* shows the user of the mobile station actively choosing an access network. While not explicitly stated, it is assumed that the Examiner’s position is that this alleged teaching shows selecting a usable connection option as recited in claim 14. Hence, because *Gao* allegedly shows a mobile station performing the task of “selecting”, the Examiner’s position appears to be that it is obvious that *Gao*’s mobile station

performs the “automatically performing identification processes” and “setting up a connection” features of claim 14.

Nothing in *Lescuyer* or *Gao*, even if combined, teaches or suggests a mobile station performing the “automatically performing identification processes” and “setting up a connection” features of claim 14. The Examiner agrees that *Lescuyer* does not show the mobile station performing the steps of the method. Likewise, nothing in *Gao* teaches or suggests ““automatically performing identification processes” and “setting up a connection”. In fact, *Gao* discusses a centralized hand over technique rather than a technique in which the mobile stations perform the claimed features. *Gao*, col. 6, line 5 - col. 7, line 24. “[W]henver a vertical handover occurs, the access router (AR) 218 informs a supervising handover gateway (HO-GW) 208 of the destination administration domain.” *Id.*, col. 6, lines 7-10. “[T]he handover gateways (HO-GW) 208 can learn and update neighborhood databases and establish MPLS paths.” *Id.*, col. 6, lines 26-28. “To support vertical handover, the access router (AR) 218 determines what kind of service the application of the mobile host (MH) 120 requires during the handover.” *Id.*, col. 6, lines 62-64. It is important to note that each of the foregoing operations is performed by the centralized entities, not the mobile stations.

Thus, even if *Lescuyer* and *Gao* independently teach or suggest the claimed features, their combination does not combine the features in the way as recited by claim 14. Accordingly, Applicants request withdrawal of the rejections to claim 14, and at least because of their dependence therefrom, to claims 15-28 for the reasons above.

CONCLUSION

Applicants respectfully submit that this application is now in condition for allowance.
Reconsideration and prompt allowance of which are respectfully requested.

Applicants believe that no additional fee is due in connection with the filing of this paper.
If any additional fee is due, or overpayment made, with regard to this paper, Applicants authorize the Director to charge any such fee, and credit any overpayment, to Deposit Account No. 02-4377.

Respectfully submitted,

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